



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/905,579	07/12/2001	Carl S. Chow	10007750-1	4263

7590 05/19/2005
HEWLETT-PACKARD COMPANY
Intellectual Property Administration
P.O. Box 272400
Fort Collins, CO 80527-2400

EXAMINER

WOO, RICHARD SUKYOON

ART UNIT	PAPER NUMBER
3639	

DATE MAILED: 05/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/905,579

Applicant(s)

CHOW, CARL S.

Examiner

Richard Woo

Art Unit

3639

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 14 February 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 19-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 19-34 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

PL

2

DETAILED ACTION

Response to Amendments

- 1) Applicant's amendments filed on February 14, 2005, with cancellation of claims 1-3 and 7-11 and the presentation of new claims 19-34, has been entered.

Applicant's arguments with respect to claims 19-34 have been considered but are moot in view of the new ground(s) of rejection.

- 2) The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Double Patenting

- 3) Claims 27-34 are objected to under 37 CFR 1.75 as being a substantial duplicate of claims 19-26, respectively. When two claims in an application are duplicates or else are so close in content that they both cover the same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

Claim Rejections - 35 USC § 103

- 4) Claims 19-34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tonkin (US 6,134,568) in view of EP 0621563 A1 (hereinafter EP).

As for Claims 1 and 27, Tonkin discloses a method comprising:

providing a client interface, wherein the client interface includes at least a portion of a network (see Fig. 1);

detecting a client inquiry via the interface (see Fig. 3);

presenting an information selection prompt via the interface in response to the client inquiry (see Figs. 4, 5B-F); and

receiving a client selection via the client interface in response to presenting the information selection prompt (see Fig. 1).

However, Tonkin does not specifically disclose the method further including the step of calculating postage for the booklet based on the total weight of the booklet and print the electronic image onto one or more sheets of print media.

EP teaches, for system and method for preparing items for mailing, that the system calculates the postage and prints it on the booklet, wherein the postage amount is calculated by the total weight of selected items with known weights (col. 5, lines 43-56).

Since EP and Tonkin are both from the same field of endeavor of printing items with known weight and combining the items to calculate the total weight, the purpose disclosed by EP would have been well recognized in the pertinent field of Tonkin.

Accordingly, it would have been obvious at the time the invention was made to a person having ordinary skill in the art to calculate the exact postage for the booklet of

Art Unit: 3639

Tonkin based on the total weight of the booklet and print the electronic image (including the postage) onto one or more sheets of print media at the document production locations (such as locations 71 to 73 in Fig. 1 of Tonkin), as taught by EP, for the purpose of charging proper postage may be applied to the corresponding booklet.

As for Claims 20 and 28, the modified method of Tonkin further discloses the method, including:

- presenting a name and address prompt via the client interface (see Fig. 9 for the name and address in Tonkin); and

- receiving a client name and postal address.

As for Claims 21 and 29, the modified method of Tonkin further discloses the method, wherein the electronic image includes the client name and postal address (see the computer system of EP reference includes the electronic image of the mail piece including the name and postal address).

As for Claims 22 and 30, the modified method of Tonkin further discloses the method, wherein the electronic image further includes an image to be purchased by the client (see Fig. 8A for the image in Tonkin).

As for Claims 23 and 31, the modified method of Tonkin further discloses the method, however, it does not specifically disclose that the image is form of sheet music.

Since Tonkin discloses the various type of image in form of graphic, picture or various type of text, it would have been obvious to one having ordinary skill in the art to

include the sheet music as one type of image for the purpose of printing the sheet music documents when requested by the client.

As for Claims 24 and 32, the modified method of Tonkin further discloses the method, wherein the image is artistic graphics (see Fig. 8A).

As for Claims 25 and 33, the modified method of Tonkin further discloses the method, wherein the image is literary text (see Id.).

As for Claims 26 and 34, the modified method of Tonkin further discloses the method, wherein the image is technical data (see Id.).

Conclusion

5) Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Art Unit: 3639

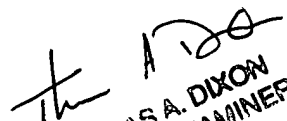
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Richard Woo whose telephone number is 571-272-6813. The examiner can normally be reached on Monday-Friday from 8:30 AM -5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Weiss can be reached on 571-272-6812. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Richard Woo
Patent Examiner
Art Unit 3639
May 13, 2005



THOMAS A. DIXON
PRIMARY EXAMINER